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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,163	11/30/2001	M'Hammed Mountassir	14081-1US JA/ld	1250

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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,163

Applicant(s)

MOUNTASSIR, M'HAMMED

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-41, 43, 44, 46-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-41, 43, 44, and 46-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, filed on 3/15/04, has been entered.

Applicant's arguments, filed 3/15/04, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

NEW MATTER

Claims 25-41, 43, 44, and 46-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25, lines 3-4, have been amended via the limitation directed to requiring "at least some of said parameters X_i involved exhibit interfering effects on the desired properties Y_j ". Support for this phrase has been cited by applicant on page 1, line 20. Consideration of said page 1 support reveals that it is directed to prior art production

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processes further characterized as being "not unusual" that some process parameters exhibit interfering effects on desired properties. This phraseology therefore is not indicated as being required or even disclosed as being part of the instant invention. The "not unusual" phrase admits that production processes may involve such interfering effects but that production processes also may not. The remainder of the instant disclosure as filed has been considered and fails to provide written basis for said claim 25 phrase thus supporting this rejection which is based on said claim 1 phrase adding NEW MATTER to the instantly claimed invention. Instant claim 40, lines 6-7, also contain this NEW MATTER. Claims which depend directly or indirectly from claims 25 or 40 also contain this NEW MATTER due to their dependence.

Claim 25, last five lines of part "iii)", now contains NEW MATTER directed to the "essentially statistically insufficient for ... quantifying said property behavior mathematical relation in the case that said relation is to be used to find optimal parameter values". Applicant points to page 2, lines 6-8, wherein there no written basis for such "essentially statistically insufficient..." limitation. Consideration of said lines 6-8 reveals that they are directed instead to quantifying existing relationships which is essentially directly opposite to the "statistically insufficient..." limitation which has been added to claim 25 thus supporting this NEW MATTER rejection. It is also noted that said page 2 of the instant application describes the prior art and not the instant invention. Consideration of the remainder of the instant disclosure as filed has also failed to reveal written basis for said part iii) limitation in claim 25. Claims which depend

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directly or indirectly from claim 25 also contain this NEW MATTER due to their dependence.

Claim 25, parts "iv)" and "v)", has been amended to cite the characterization of a product via property behavior mathematical relations which adds NEW MATTER to the claim. Applicant argues that this should be clearly understood from original claim 25. Consideration of original claim 25 reveals that properties Y_j are cited as characterizing a product but not "property behavior mathematical relations". Thus, this limitation phrase adds NEW MATTER to claim 25. This NEW MATTER had also been added to claim 40, last 16 lines, at several places therein. Consideration of the remainder of the instant disclosure as filed has also failed to reveal written basis for said parts iv) and v) limitations in claim 25 and the last 16 lines of claim 40. Claims which depend directly or indirectly from claims 25 or 40 also contain this NEW MATTER due to their dependence.

Claim 40 has been amended to require parameter "n" to be "greater than two" citing examples for support. Consideration of said examples and the instant disclosure as a whole has failed to reveal written support for this limitation thus causing this rejection which indicates that said limitation is NEW MATTER. Claim 53 also contains this NEW MATTER limitation. Claims which depend directly or indirectly from claims 40 or 53 also contain this NEW MATTER due to their dependence.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices

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published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

May 28, 2004

Ardin H. Marschel 5/28/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER